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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,473	08/25/2000	Andrea Waxler	11790-003001	5900
26161	7590	10/09/2003	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			EL HADY, NABIL M	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/648,473

Applicant(s)

WAXLER, ANDREA

Examiner

Nabil M El-Hady

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. Claims 1-14 are pending in this application.
2. This application is objected to because it contains a data file on CD-ROM/CD-R, however, the transmittal letter does not list for each compact disc, the machine format, the operating system compatibility, a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret the information on the compact disc as required by 37 CFR 1.52(e)(3). A statement listing the required information is required.
3. Portions of this application are contained on compact disc(s). When portions of an application are contained on a compact disc, the paper portion of the specification must identify the compact disc(s) and list the files including name, file size, and creation date on each of the compact discs. See 37 CFR 1.52(e). Compact disc labeled **"Practicefirst.com"** is not identified in the paper portion of the specification with a listing of all of the files contained on the disc. Applicant is required to amend the specification to identify each disc and the files contained on each disc including the file name, file size, and file creation date.
4. This application contains compact disc(s) as part of the originally filed subject matter, but does not contain incorporation by reference statement for the compact discs. See 37 CFR 1.77(b)(4). Applicant(s) are required to insert in the specification an incorporation-by-reference of the material on the compact disc(s).
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, and 9-13 are rejected under 35 U.S.C. 102( b) as being anticipated by Christie et al. (US 6,182,117).

7. As to claim 1, Christie discloses the invention as claimed including a method of work sharing and communicating over the internet with a web site system (abstract; and col. 8, lines 5-13) that includes at least a communication component and a data storage component (Fig. 2B; and col. 9, lines 10-50) allowing users to electronically input data over the internet (Fig. 2B) comprising: electronically storing the data received over the internet in the data storage component of the web site system (col. 3, lines 24-25; 210, 220, Fig. 2B); automatically determining to which other related portions of the web site system the electronically stored data will be sent (col. 4, lines 22-24); automatically distributing the electronically stored data to the automatically determined other related portions of the web site system (col. 4, lines 24-27); electronically storing the data distributed to the other related portions of the web site system in the data storage component (col. 4, lines 41-45); and automatically communicating over the internet to other relevant users of the newly stored data in the web site system (col. 4, lines 24-27).

8. As to claim 11, the claim is rejected for the same reasons as claim 1 above. In addition, Christie discloses an apparatus for work sharing and communicating comprising a computer at a web site system that includes at least a communication component and a data storage component allowing users in professional offices to electronically input data over the internet (Fig. 2B).

9. As to claim 2, Christie discloses said automatically determining is controlled by a computer program programmed to determine which portions of the web site system the electronically stored data will be sent (col. 9, line 66 to col. 10, line 20).

10. As to claim 3, Christie discloses the computer program controls determining to which portions of the web site system the electronically stored data is relevant, and enacts the automatic distribution to distribute the electronically stored data accordingly (col. 9, line 66 to col. 10, line 20).

11. As to claim 9, Christie discloses the electronic storage occurs on a remote data processing machine that can be accessed from remote terminals via a channel from the group consisting of the Internet and an intranet (Fig. 2B; and col. 8, lines 46-51).

12. As to claim 10, Christie discloses the automatic distributing is controlled by a computer program programmed to distribute the electronically stored data to the automatically determined portions of the web site system (col. 9, line 66 to col. 10, line 20).

13. As to claim 12, Christie discloses the web site system includes terminals intercoupled to the computer by a link (Fig. 2B; and col. 9, lines 16-25).

14. As to claim 13, Christie discloses the data storage comprises data storage device that stores the first input data and a data storage device that stores the data distributed to the other related portions of the web site system (col. 3, lines 24-31).

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christie et al. (US 6,182,117) in view of Swartz et al. (US 6,236,994).

17. As to claim 4, Christie does not necessarily disclose a portion of a knowledge-management system. Swartz, on the other hand, discloses a portion of a knowledge-management system in an information sharing and communicating system (col. 4, lines 12-15). It would have been obvious to one skilled in the art at the time of the invention to combine the teachings of Christie and Swartz because Swartz knowledge-management system would enhance the functionality of Christie's system by permitting an efficient establishment and use of a knowledge repository in an organization or enterprise that reflects the collective learning of the individuals, shared groups, and systems employed by the organization (see Swartz, col. 5, lines 30-35, and col. 6, lines 8-10).

18. As to claim 5-8, Swartz discloses the need for the knowledge-management system for a wide range of industries (col. 1, lines 33-54). It would have been obvious to one skilled in the art at the time of the invention that a service industry would also need knowledge-management system for the same obvious reasons of enhancing the prospects of the industry by permitting an efficient establishment and use of a knowledge repository within the industry that reflects the collective learning of the

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individuals, shared groups, and systems employed by the industry (see Swartz, col. 5, lines 30-35, and col. 6, lines 8-10). It would have been obvious too to one skilled in the art at the time of the invention that a service industry would be covering group of a medical practice, hospital, and a medical health maintenance organization, a group consisting of a law office, law firm, courthouse, and a legal business entity, or a group consisting of an accounting firm, tax firm, temporary employment firm, financial and employment business entity.

19. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Hunnincut et al. (US 5,889,952), hereafter "Hunnincut".

20. Hunnincut et al. is cited by the applicant in IDS paper No. 5 filed on 3/4/2002.

21. As to claim 14, Hunnincut discloses the invention as claimed including a method for enrolling and grouping users in professional offices comprising assigning enrolled users into specific work groups (inherent in col. 7, lines 38-40); assigning the specific work groups levels of access to a web site system over the internet (inherent in col. 7, lines 40-62); limiting the specific work group to the assigned level of access to the web site system (col. 7, lines 59-62; and Fig. 5); and providing communication capabilities over the internet to the specific work groups which are limited to the work groups assigned level of access (inherent in col. 7, lines 50-55).

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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Schwartz et al. (US 5,913,032); Marks et al. (US 6,463,447); Krishnan (US 6,366,956); Taylor (US 5,832,497); Fernandes (US 6,014,135); Donoho et al. (US 6,256,664); Booman et al. (US 6,216,169); Zhang et al. (US 6,016,478) ; and Loring et al. (US 6,195,641).

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M El-Hady whose telephone number is (703) 308-7990. The examiner can normally be reached on 9:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai T An can be reached on (703) 305-9678. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Nabil El-Hady, Ph.D., M.B.A.  
Primary patent Examiner  
September 15, 2003